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GERALD LEVY
KANE DALSIMER SULLIVAN KURUCZ LEVY
711 THIRD AVENUE
NEW YORK NY 10017

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EXAMINER

CHU, K

ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 16

Application Number: 08/891,308

Filing Date: July 10, 1997

Appellant(s): ONAGI, NOBUAKI

Gerald Levy

For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed February 5, 2001.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying that there are no related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

- (a) This appeal involves claims 11-23; and
- (b) Claims 1-10 are allowed.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because the summary does not properly refer to the figures and specification and is too brief describing Appellant's invention which is an optical disk shown in figs 2A-2D where information pits (101) are reproducible by a super resolution reproduction means. In addition, the optical disk has address pits (PP) arranged in low pit density which are reproducible by a normal resolution reproduction means. See column 2, lines 10-17.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 11-23 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 11-23 are rejected under 35 U.S.C. 251 as being an improper recapture of canceled claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

In parent application 08/126,515, Appellant filed amendment dated December 27, 1994 to overcome the Examiner's 103 rejection. In the amendment, Appellant/patentee added the following new features (in bold) to independent claims 1, 3 and 8. Some of the features are not present in instant pending claims 11-23 (underlined). Note that the "super resolution" limitation is not in bold because it was not added by the amendment; however, the limitation is underlined to represent deletion thereof from the instant pending claims 11-23. From parent application amended claim 1:

- (a) "a plurality of information pits recorded on said plurality of recording tracks as magnetization directions at said recording surface in a magneto-optical recording operation";
- (b) "information pits are arranged with such a high pit density as to be non-reproducible by a normal resolution reproduction by use of the light spot but reproducible by a super resolution reproduction by use of the light spot";
- (c) "an address pit having a convex or concave shape on the recording surface and being arranged with such a low pit density as to be reproducible by a normal resolution reproduction by use of the light spot"; and
- (d) "optical disk, to be reproduced by forming a light spot with a predetermined diameter".

Appellant in the amendment of December 27, 1994, on page 7, lines 6-8, argued that "the claimed information pit nor address pit of claim 1 is disclosed or suggested by the cited art".

Previous to this statement, appellant defined what was meant by "information pit" and "address pit" on page 6, line 17 - page 7, line 5, "The examiner will further note that amended claim 1 calls for a plurality of information pits **recorded on a plurality of recording tracks as magnetization direction at the recording surface in a magneto-optical recording operation**. The information pits are arranged with such a high pit density as to be nonreproducible by a normal resolution reproduction by use of a light spot with a predetermined diameter but reproducible by a super resolution reproduction by use of a light spot the predetermined diameter.

The address pit for address reproduction is formed in advance for the recording operation on the recording surface with respect to one set of recording tracks adjacent to each other in a radial direction of the optical disk. The address pit has a **convex or concave shape on the recording surface and is arranged with such a low pit density as to be reproducible by a normal resolution reproduction by use of the light spot of the predetermined diameter.**"
(emphasis added)

Appellant's references to added features are again in bold. Appellant's references to features not present in instant pending claims 11-23 are underlined.

In response to the amendment, the parent application was allowed.

On the record, the newly submitted claims 11-23 in this reissue application lack the aforementioned underlined features that were specifically argued as to patentability over Prior Art. In other words, the claims 11-23 are broader than original ^{patented} claims in a manner directly pertinent to subject matter surrendered during prosecution of the parent application.

Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Appellant's attention is directed to MPEP 1412.02 and 1412.03.

(9) Response to Argument

In the Remarks filed on May 15, 2000, Appellant stated that the new claims 11-23 were added to correct the errors in patent claims 1-10 which have amended features added to overcome the 35 USC 112 rejection.

In the Appellant's Appeal Brief, Appellant maintains his previous argument that the new claims 11-23 was added to correct the errors in claims 1-10 which have amended features added to overcome the 35 USC 112 rejection.

However, the pertinent features added by and argued in the amendment made to overcome the Examiner's 103 rejection are noted, supra. Again, in Appellant's remarks filed on December 27, 1994, on page 6, line 17 - page 7, line 8, Appellant states that specifically added features are not taught by the cited art. In fact, Appellant also specifically argued the "super resolution" feature that was already present in the claims prior to the December 27, 1994 amendment and which feature is now also not claimed. In response to the amendment, the Examiner allowed the '515 application with claims 1-10 based on Appellant's amendment. See the Examiner's Reason of Allowance dated February 28, 1995.

On the other hand, the 112 rejection regarded insufficient support of the subject matter "super resolution reproduction" and indefiniteness as to how to reproduce "address pit".

In claims 11, 14 and 20, the previous amended and argued features "magneto-optical disk" and "magnetization directions" are not included. These limitations were added to overcome the Examiner's 103 rejection. Therefore, new claims 11-23 without the above noted features are considered improper recapture of canceled claimed subject matter (an optical disk) surrendered in the application for the patent upon which the present reissue is based.

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In claims 11, 14 and 20, the previous amended and argued features "high pit density" and "low pit density" are not included. Especially, the amendment argument states that the high pit density is reproducible by a super resolution reproduction. These limitations were added to overcome the Examiner's 103 rejection and deletion of these limitations is Recapture and is not an "error" correctable by Reissue.

Furthermore, even assuming arguendo that the amendment was made to overcome the 35 USC 112 rejection, the new claims 11-23 still lack the original claims' subject matter "reproducible by super resolution reproduction", which was specifically referred to in the Reasons for Allowance in the parent application. Appellant did not provide a contrary comment in response thereto prior to issuance of the patent. Therefore, appellant acquiesced to the presence of such limitation as to the patentability determination and deletion of such limitation represents an impermissible attempt to Recapture surrendered claimed subject matter.

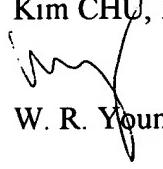
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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:


Kim CHU, Examiner AU 2651


W. R. Young, Primary Examiner AU 2651


David Hudspeth, SPE AU 2651


DAVID HUDSPETH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

May 3, 2001

GERALD LEVY
KANE DALSIMER SULLIVAN KURUCZ LEVY
711 THIRD AVENUE
NEW YORK, NY 10017